

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed December 17, 2008. At the time of the Office Action, Claims 1-20 were pending in this Application. Claims 1-20 were rejected. Claims 2, 3, 7-9, 13, 14, and 18-20 are herein withdrawn due to a previous election/restriction requirement, as discussed below. Claims 1 and 12 are herein amended to further define various features of Applicants' invention. Applicants respectfully request reconsideration and favorable action in this case.

Election/Restriction

Applicants indicated in its Response to Election/Restriction filed November 14, 2008 that all claims read on the elected embodiment (Figure 6). However, the Examiner alleges that "Claims 2-3, 7-9, 13-14 and 18-20 include specific structural features not illustrated in or described with respect to the elected embodiment and should be withdrawn." In order to advance prosecution, Applicants herein withdraw Claims 2-3, 7-9, 13-14 and 18-20 as suggested by the Examiner.

Drawings

The Examiner objects to the drawings because Figure 6 of the elected embodiment allegedly fails to show features of Claims 2-3, 7-9, 13-14 and 18-20. As discussed above, Claims 2-3, 7-9, 13-14 and 18-20 are herein withdrawn. Accordingly, Applicants request that the objections to the drawings be withdrawn.

Rejections under 35 U.S.C. § 112

Claims 2-3, 7-9, 13-14 and 18-20 were rejected by the Examiner under 35 U.S.C. §112, first paragraph, as allegedly not being enabled by the elected embodiment (Figure 6). As discussed above, Claims 2-3, 7-9, 13-14 and 18-20 are herein withdrawn. Accordingly, Applicants request that rejections under 35 U.S.C. §112, first paragraph be withdrawn.

Rejections under 35 U.S.C. §§ 102 and 103

Claims 1, 6, 12 and 17 were rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,276,884 issued to Bueter ("*Bueter*").

Claims 1-6 and 12-17 were rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 3,079,181 issued to Wissel ("*Wissel*").

Claims 2, 10 and 13-14 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Bueter*.

Claim 11 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Bueter* in view of U.S. Patent No. 5,249,556 issued to Emmitt ("*Emmitt*").

Claim 11 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Wissel* in view of *Emmitt*.

For prior art based rejections under either 35 U.S.C. §102 or 35 U.S.C. §103, the prior art reference(s) much teach every limitation of the claim at issue. Regarding rejections under 35 U.S.C. §102, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "the identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co. Ltd.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Similarly, regarding rejections under 35 U.S.C. §103, in order to establish a prima facie case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Applicants respectfully submit that the cited references *Bueter*, *Wissel*, and *Emmitt*. do not teach every limitation of Applicants' claims as amended. For example, amended Claim 1 requires:

- a first section, extending a length of multiple thread courses, in which thread flanks of the external screw thread are in direct contact with corresponding thread flanks of the internal screw thread for transmitting a tightening force; and

- a second section, also extending a length of multiple thread courses, in which “thread flanks of the external screw thread are not in direct contact with corresponding thread flanks of the internal screw thread such that a continuous cavity for receiving the thread sealant is formed between the thread flanks of the external screw thread and the thread flanks of the internal screw thread, the continuous cavity extending axially a length of multiple courses of the internal screw thread”;
- wherein the transition between the first and second sections is defined by at least one particular thread course of the external thread/internal thread having a different pitch than the remaining thread courses of the external thread/internal thread.

For the Examiner's reference, amended Claim 1 includes limitations similar to those of dependent Claims 4/5, as well as additional limitations.

Bueter, *Wissel*, and *Emmitt* do not teach these limitations. *Bueter* does not teach at least one particular thread course of the external thread/internal thread having a different pitch than the remaining thread courses of the external thread/internal thread to form a transition between first and second sections of a screwed connection. In fact, *Bueter* teaches that “[t]he essence of the invention lies in the fact that at least one of the threaded parts of the threaded pairing consists of a preferably wedge-shaped, flank-bearing basic body which has a cylindrical and a non-cylindrical part along its axial length, with the same pitch of thread running throughout.” (col. 2, lines 56-60) (emphasis added). Thus, not only does *Bueter* does not teach this limitation of amended Claim 1, but *Bueter* explicitly teaches away from amended Claim 1.

Wissel does not teach “a second section extending a length including multiple courses of the internal screw thread,” wherein “thread flanks of the external screw thread are not in direct contact with corresponding thread flanks of the internal screw thread such that a continuous cavity for receiving the thread sealant is formed between the thread flanks of the external screw thread and the thread flanks of the internal screw thread, the continuous cavity extending axially a length of multiple courses of the internal screw thread.”

Wissel teaches a box-and-pin joint for taking heavier loads than previous box-and-pin joints. (col. 1, lines 51-52). In *Wissel*'s joint, either or both screw threads deviate from the normal tapering screw thread such that "when the pin is screwed tight into the box, the outer flanks of the pin thread and the inner flanks of the box thread are more heavily loaded than the other flanks. Thus, the threads are substantially equally loaded along the entire thread contact length without plastic deformation, when a connection is screwed power-tight." (col. 1, lines 51-60).

None of the embodiments shown in *Wissel* include a section that extends multiple courses of the screw thread, in which thread flanks of the two threads are not in direct contact with each other such that a continuous sealant cavity is formed that extends axially for multiple courses of the thread, as required by amended Claim 1. In fact, because *Wissel* is concerned with maximizing the strength of a box-and-pin for taking heavier loads, particularly by providing a connection in which the threads are equally loaded along the length of the connection, *Wissel* actually teaches away from including a portion that extends for multiple thread courses in which the thread flanks do not contact each other (i.e., not providing significant load-supporting function).

Emmitt does not teach any of the limitations of amended Claim 1 discussed above. The Examiner merely provided *Emmitt* for allegedly teaching the use of a screwed connection in a fuel pump.

For at least these reasons, Applicants respectfully request reconsideration and allowance of amended Claim 1, as well as all claims that depend from Claim 1. In addition, for analogous reasons, Applicants respectfully request reconsideration and allowance of amended independent Claim 12, as well as all claims that depend from Claim 12.

CONCLUSION

Applicants have made an earnest effort to place this case in condition for allowance in light of the remarks set forth above. Applicants respectfully request reconsideration of the pending claims.

Applicants respectfully submit a Petition for a One Month Extension of Time. The Commissioner is authorized to charge the fee of \$130 to Deposit Account No. 50-4871 of King & Spalding LLP in order to effectuate this filing. Applicants believe no other fees are due; however, should the Commissioner deem that any additional fees are due, including any fees for any additional extensions of time, the Commissioner is hereby authorized to debit said fees from deposit account number 50-4871.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.457-2030.

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